



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/828,330	03/28/97	MORGAN	W I-852-002

FM31/0918

NORMAN P FRIEDERICH
FRIEDERICHS LAW FIRM
200 SOUTH SIXTH STREET
SUITE 425 PILLSBURY CENTER
MINNEAPOLIS MN 55402

EXAMINER	
CANFIELD, R	
ART UNIT	PAPER NUMBER
3621	
DATE MAILED: 09/18/98	

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/828,330

Applicant(s)

Morgan

Examiner

Robert Canfield

Group Art Unit

3621



☒ Responsive to communication(s) filed on Jun 9, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-12, 14-16, and 18-48 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1, 2, and 4 is/are allowed.

☒ Claim(s) 3, 5-12, 14-16, and 18-48 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3621

1. This Office action is in response to applicant's amendment filed 6/9/98. Claims 13 and 17 have been canceled. Claims 1-12, 14-16, and 18-48 remain pending.

2. In the Office action mailed 3/9/98 the examiner inquired if the patent sought to be reissued were involved in litigation and if so any documents/materials which would be material to the patentability of the application be made of record.

Applicant's response states that the patent is in litigation as identified with the original filing papers and that all documents/materials material to the patentability have been made of record. The examiner fails to find any indication of litigation or said documents/materials with the original filing papers.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore the cable anchored at either of its ends to anchoring means, the anchoring trench, the cover supported above a pond, aqueous solution, and tank must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Applicant argues in his response that because the various features recited in the claims are old and well known it is not required that they be shown and points to 37 CFR 1.83(b). This is not found persuasive because 37 CR 1.83(a) requires **every feature** specified in the claims be

Art Unit: 3621

shown. It further states that if conventional (ie. old and well known) features are claimed and their detailed illustration is not required to the understanding of the invention then they should be illustrated in the drawing in the form of a graphical symbol or a labeled representation.

37 CFR 1.83(b) does not recite that old and well known features need not be shown as alleged by applicant. In fact 37 CFR 1.83(b) states that a view must be shown showing the connection of the old structure with the invention. The figures fail to show the cover with the cable anchored at either of its ends to anchoring means, in combination with an anchoring trench, or supported above a pond, aqueous solution, and tank either explicitly or schematically. The drawing objection is maintained.

4. The rejections under 35 U.S.C. 112(1) in the Office action mailed 3/9/98 are vacated. The loop was initially considered only to include the U shaped portion at approximately reference #7. However, as applicant has correctly pointed out the tail ends of the cable 7 are also part of the loops. Applicant's arguments concerning the insulation means are found persuasive. Applicant points out that column 1 lines 11 and 12 discuss that it was known at the time of the invention to secure the covers by an anchoring trench. Finally, the examiner agrees that a tank would be a recognized equivalent term "to a man-made, usually rectangular, settling pond" and is therefore supported by the original disclosure.

Art Unit: 3621

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 40, ~~41~~ and 45 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is an inadequate written description of an embodiment linking adjacent panels with a loop and an additional fastener which is inserted through at least one panel opening which is what is now recited in these claims.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 has been amended to recite "through" after "disposed" which is completely unclear. The examiner also fails to see how the claim further limits claim 1. Applicant states in his remarks that claim 1 does not require the loop passing through the grommet. This is not

12/18
on "hole through"
claim 1 could cover

Art Unit: 3621

found persuasive as claim 1 calls for "one cable disposed through said vertical spaced grommets and formed into a loop. Since the cable forms the loop and the cable is disposed through the grommet the loop is inherently disposed through the grommet.

9. The remaining 112(2) rejections from the Office action mailed 3/9/98 are vacated.

10. The new matter rejections under 35 U.S.C. 251 are vacated in light of the comments made concerning the 112(1) rejections.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

12. Claims 5-7, 9-18, 23, 25, 26, 28-41 and 46 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 93/11330.

Art Unit: 3621

Figure 2 shows adjacent rectangular panels filled with insulation (air). The adjacent panels are linked and delinked using grommets 15 and loop 17 as shown in figure 5.

13. Claims 5-7, 9, 10, 12-19, 23, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,590,714 to Walker.

See entire description. Particularly note figures 2 and 3.

Note the recitation "A pond cover" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Also note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Art Unit: 3621

The cover of Walker meets all positively recited structural limitations of the above claims and is capable of covering, a waste treatment pond or tank.

14. Claims 5-7, 9, 14, 15, 18-20, 22, 25 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 5,197,239 to Glynn et al.

See the entire disclosure.

Again note the remarks above concerning preambles and intended use.

Concerning claim 9 the cover itself is inherently a means for controlling temperature.

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 8, 11, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,590,714 to Walker.

Walker provides all of the elements/steps of these claims except for specifying the particular dimensions, making the seams from a weld, and showing the tie down cable.

The dimensions of the panels are nothing more than choices of design which would have been obvious at the time of the invention to one having ordinary skill in the art. One of ordinary

Art Unit: 3621

skill in the art would have readily recognized that the panels of Walker could be varied in size to meet particular needs.

Walker discloses a seam, preferably a stitched seam. However welded seams are well recognized art equivalents to plastic seams when joining sheets of plastic material. It would have been an obvious substitution of mechanical equivalents at the time of the invention to one having ordinary skill in the art to have substituted a welded seam for the stitched seam of the panels of Walker.

While Walker fails to show his panels tied down with cable anchoring means he does suggest in the background of the invention that it was well known at the time of the invention to hold panels down with ropes. Figure 3 clearly provides an eyelet on the linking means for passage of a rope or cable to secure the panels to an anchor means. It would have been obvious to one having ordinary skill in the art that Walker had intended his panels to be tied or anchored down with cables such as ropes through the grommets and/or eyelets linking means shown in figure 3.

Applicant admits in his disclosure and remarks that it was well known at the time of the invention to provide covers over ponds/tanks and secure the tie down means with an anchoring trench. It would have been obvious at the time of the invention to one having ordinary skill in the art that the cover of Walker could be used over a settling pond or tank and when used as such the ropes or cables passing through the eyelets would be anchored in an anchoring trench as is admitted as well known at the time of the invention.

Art Unit: 3621

17. Claims 24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,590,714 to Walker in view of U.S. Patent 3,038,171 to Bartolucci.

Walker provides a cover meeting all of the claimed limitations of these claims as noted in the above rejection under 35 U.S.C. 102 except for specifying that the tarpaulin is used to cover an aqueous solution or a tank.

Bartolucci provides a teaching that it was well known at the time of the invention to use tarpaulins to cover swimming pools. Swimming pools are considered to meet both “aqueous solution” and “tank”.

It would have been obvious at the time of the invention to one having ordinary skill in the art to have used the tarpaulin as taught by Walker to cover a swimming pool as taught by Bartolucci. It would have been obvious to keep out debris and to insulate the water.

18. Claims 28-39, 42-44, 46, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker '714 in view of WO 93/11330.

Walker provides all of the elements of the panel structure as noted in the above rejections except for providing that the means for linking is a loop passing through the grommets.

The WO patent teaches in figure 5 that it was well known at the time of the invention to use a loop 17 passed through grommets to link adjacent overlapping panel members.

Art Unit: 3621

It would have been obvious at the time of the invention to one having ordinary skill in the art to have linked adjacent panels of Walker using a loop system as taught by WO in figure 5.

Note that claim 48 only presents an intended use for the cover.

19. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker '714 as modified by WO '330 further in view of Bartolucci '171.

Walker as modified by the WO patent provides a cover and linking system meeting all of the claimed limitations of the claim as noted in the above rejections except for specifying that the tarpaulin is used to cover an aqueous solution or a tank.

Bartolucci provides a teaching that it was well known at the time of the invention to use tarpaulins to cover swimming pools. Swimming pools are considered to meet both "aqueous solution" and "tank".

It would have been obvious at the time of the invention to one having ordinary skill in the art to have used the tarpaulin as taught by Walker to cover a swimming pool as taught by Bartolucci. It would have been obvious to keep out debris and to insulate the water.

20. Claims 1, 2, and 4 are allowable over the prior art of record.

21. Claim 3 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action.

Art Unit: 3621

The specific linking and securing means recited in the claims is not taught or adequately suggested in the prior art of record.

22. Applicant's arguments filed 6/9/98 have been fully considered but they are not persuasive.

Applicant's arguments with respect to the rejection of claims 24 and 27 under 35 U.S.C. 102(b) in view of Walker have been considered but are moot in view of the new ground(s) of rejection. Note that claim 25 fails to claim the cover in combination with a waste treatment pond as claims 24 and 27 claim it in relation to an aqueous solution and tank respectively.

In response to applicant's argument that Walker and Glynn et al. fail to show certain features of applicant's invention, it is noted that the feature upon which applicant relies (i.e., a loop) is not positively recited in the rejected claim 5 and its dependents. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Note that claim 5 recites a means for interconnecting adjacent panels through adjacent openings with a loop. The loop is not claimed. The means for interconnecting through openings with a loop is claimed. The grommets of Walker and Glynn et al. are considered to meet this limitation.

In response to applicant's argument that Walker is non-analogous art this is not found persuasive as analogous art is not a consideration under 35 U.S.C. 102. Further note that it has been held that under 35 U.S.C. 103 a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the

Art Unit: 3621

applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, tarpaulins such as that disclosed and claimed by Walker are considered both in the field of applicant's endeavor as they are well known covers for water tanks (See U.S. 3,038,171 to Bartolucci), and they are reasonable partitioned the particular problem applicant was concerned with (providing an insulating cover).

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Canfield whose telephone number is (703) 308-2168.

Robert Canfield


September 14, 1998

Robert Canfield
Primary Examiner